

REMARKS

This responds to the Office Action mailed on March 19, 2007.

Claims 2-8, 19-21 and 34-37 are amended, no claims are canceled, and no claims are added; as a result, claims 1-90 are now pending in this application.

§112 Rejection of the Claims

Claims 2-8, 19-21 and 34-37 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. The rejected claims were amended for clarity.

§103 Rejection of the Claims

Claims 1-20, 25-26, 28-30, 34-40, 48-68, and 90 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hageman (U.S. 5,231,814) in view of Wentworth (U.S. 4,364,984).

Claim 27 was rejected under 35 USC § 103(a) as being unpatentable over Hageman, in view of Wentworth as described above for claims 1-20, 25-26, 28-30, 34-40, 48-68 and 90, in further view of Naipawer, III et al. (U.S. 2002/0037405).

Claims 72-74 and 79-80 were rejected under 35 USC § 103(a) as being unpatentable over Hageman in view of Wentworth as described above claims 1-20, 25-26, 28-30, 34-40, 48-68 and 90, in further view of Narukawa et al. (U.S. 4,148,781).

Claims 41-47 were rejected under 35 USC § 103(a) as being unpatentable over Hageman in view of Wentworth as described above for claims 1-20, 25-26, 28-30, 34-40, 48-68 and 90, in further view of Speaks et al. (U.S. 5,665,798).

Claims 75-78 were rejected under 35 USC § 103(a) as being unpatentable over Hageman in view of Wentworth as described above for claims 1-20, 25-26, 28-30, 34-40, 48-68 and 90, in further view of Ueda et al. (U.S. 5,064,592).

Claims 69-71 were rejected under 35 USC § 103(a) as being unpatentable over Hageman in view of Wentworth as described above for claims 1-20, 25-26, 28-30, 34-40, 48-68 and 90, in further view of Wilson et al. (U.S. 6,251,495).

Claims 81-89 were rejected under 35 USC § 103(a) as being unpatentable over Hageman in view of Wentworth as described above for claims 1-20, 25-26, 28-30, 34-40, 48-68 and 90, in further view of Radcliffe et al. (U.S. 6,136,408).

Regarding Claim 1, the Examiner did not make out a *prima facie* case of obviousness. In order to show obviousness, there must be a reasonable expectation of success. The reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. The Examiner did not point out any evidence in the prior art concerning an expectation of success and may not be aware of the circumstances surrounding the development of the present invention in light of what a person of ordinary skill in the art knew at the time of the invention.

Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). See also *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207-08, 18 USPQ2d 1016, 1022-23 (Fed. Cir.), cert. denied, 502 U.S. 856 (1991). Applicant asserts that one of ordinary skill in the art would not have had a reasonable expectation of success in adhering a radiant barrier material to a blanket of substantially oriented flakes (e.g., oriented strand board) in a single step. The Hageman reference discloses the application of a barrier to a composite board in a "post production" or "off-line" manner, such that the composite board is manufactured first and the radiant barrier added at a later time in a separate process. Applicant's invention allows for the application of a radiant barrier material in an "in-line" manner, such that the resins of a radiant barrier oriented strand board are cured together to form a substantially more uniform board that performs better, is cheaper and is made more quickly and easily compared to the board of the Hageman reference.

Because the radiant barrier (one embodiment includes a metallic foil and backing material) was so delicate compared to the strand board, a number of complications were recognized by those skilled in the art before the presently claimed invention:

- 1) Any resin between the metallic foil/backing material or backing material/blanket of oriented flakes could seep over the edges of the blanket when compressed, thereby providing a possibly inoperable product;
- 2) The apertures or holes could be uncontrollably clogged by the resin, thereby providing a possibly inoperable product;
- 3) The foil/backing material and/or resin could stick to the press, risking damage to expensive equipment and thereby providing a possibly inoperable product;

4) The resin between the backing and blanket could mix and form and vapor impermeable barrier, reducing or eliminating the board's ability to "breathe", thereby providing a possibly inoperable product;

5) The press could tear the foil and /or backing material while pressing and also while removing the pressure from the press, thereby providing a possibly inoperable product;

6) The choice of adhesives to bind the radiant barrier to the blanket was complicated by the fact that they had to cure under conditions suitable for manufacturing the blanket of substantially oriented flakes without importing negative properties on the produced board (e.g., discoloration, bubbling, imperfections, etc.), thereby providing a possibly inoperable product.

Because these and possibly other issues could affect the ability of the board to meet industry standards for moisture permeability and durability as a construction material, it was believed that constructing a radiant barrier oriented strand board according to the claimed invention would not be feasible or even possible. Such a situation provides some of the strongest evidence for nonobviousness. Applicant respectfully requests that the rejection be removed and that all claims are in condition for allowance. Because all claims (except Claim 90, which has at least the same limitations as Claim 1) depend directly or independently from Claim 1, it is believed that they are nonobvious as well.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6920 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date July 19, 2007

By /  /

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19th day of July 2007.

KIMBERLY BROWN

Name


Signature